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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/030,499 | 03/25/2002 | Tonis Pilvisto | 104-1099 | 2172 |

35236 7590 07/19/2004

THE CULBERTSON GROUP, P.C.
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EXAMINER

FLANAGAN, BEVERLY MEINDL

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3739

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|--|--|
| Office Action Summary | Application No. 10/030,499 | Applicant(s) PILVISTO, TONIS | |
| | Examiner Beverly M. Flanagan | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Finality of Previous Office Action

The finality of the previous Office action (mailed January 27, 2004) is hereby withdrawn.

Previously Set-Forth Rejections

The following rejections set forth in the previous Final Office action are hereby withdrawn in view of applicant's arguments, filed with the amendment of April 27, 2004, which are found to be persuasive: The 35 U.S.C. 102(b) rejection of claims 12, 14-23 and 25-29 as being anticipated by Sato (U.S. Patent No. 3,557,780) and the 35 U.S.C. 103(a) rejection of claims 13 and 24 as being unpatentable over Sato (U.S. Patent No. 3,557,780) in view of Kovalchek (U.S. Patent No. 5,549,542).

The following new grounds of rejection are set forth:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,699,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12-27 of the instant application are merely broader than claims 1-10 of U.S. Patent No. 6,699,182 (hereinafter, the '182 patent).

Claim 1 of the '182 patent contains all of the limitations recited in claims 12 and 23 of the instant application and additional elements, such as an elongated tip and a tip control device, that claims 12 and 23 of the instant application do not recite. Claims 12 and 23 of the instant application differ from claim 1 of the '182 patent in the recitation that in claims 12 and 23 of the instant application, the pulling and/or pushing elements each act on the shaft "at locations spaced apart from the proximal end of the shaft" whereas claim 1 of the '182 parent recites "at difference distances from the proximal end of the shaft". Since the recitation of "at different distances from the proximal end of the shaft" is narrower than the recitation "at locations spaced apart from the proximal end of the shaft" (i.e., the recitation of spaced apart does not necessarily require that the elements be positioned at different distances), claims 12 and 23 of the instant application are broader than claim 1 of the '182 patent.

The following is a list of the claims in the instant application and the claims in the '182 patent to which they correspond (are either identical to or not patentably distinct from):

Instant App. Claim No.

'182 Patent Claim No.

| | |
|----|----|
| 12 | 1 |
| 13 | 2 |
| 14 | 3 |
| 15 | 4 |
| 16 | 5 |
| 17 | 6 |
| 18 | 7 |
| 19 | 8 |
| 20 | 9 |
| 21 | 10 |
| 22 | 5 |
| 23 | 1 |
| 24 | 2 |
| 25 | 4 |
| 26 | 7 |
| 27 | 8 |

Allowable Subject Matter

Claims 28 and 29 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
